

Applicants: Sharon Cohen-Vered, et al.
Serial No.: 10/758,572
Filed : January 14, 2004
Page : 8

Remarks

Claims 1-19, 21, 31, 32, 41-43, 52, 53, 57 and 58 were pending in the subject application. By this Amendment, applicants have added back previously canceled claims 54, 55 and 56 as new claims 59, 60 and 61, respectively. Accordingly, claims 1-18, 31, 42, 53, 57-61 will be pending and under examination upon entry of this amendment.

In the August 25, 2004 Office Action, the Examiner required restriction of the invention under 35 U.S.C. §121 to one of the following allegedly independent and distinct inventions: Group I, comprising claims 1-18, 31, 42, 53, 57, and 58; Group II, comprising claim 19; and Group III comprising claims 21, 32, 41, 43, and 52.

In response, applicants elect, with traverse, claims 1-18, 31, 42, 53, 57, 58 and new claims 59-61, corresponding to **Group I**, drawn to a pharmaceutical composition. Applicants, however, traverse the restriction of Groups II and III from elected Group I on the ground that an incorrect analysis has been used to support the requirement for restriction. Specifically with respect to the restriction of Group III from Group I, the analysis provided in Section 2 of the August 25, 2004 Office Action merely alleges that, "the pharmaceutical composition of Invention I can be made by another and materially different process." However, no such process is cited by the Examiner. A mere allegation that something "can" be done without an indication of what process can be used, or if any process other than applicants' is available (note, applicants' pharmaceutical composition is novel), does not satisfy M.P.E.P. §806.05(f). Therefore, the restriction of the process claims of Group III from the product claims of Group I is improper.¹

¹ Applicants note and appreciate the Examiner's offer to rejoin the process of making claims once the elected product claims are found allowable. However, the question of rejoinder is only reached if the initial restriction is proper. In this situation, it is not. Furthermore, rejoinder would be of the

Applicants: Sharon Cohen-Vered, et al.
Serial No.: 10/758,572
Filed : January 14, 2004
Page : 9

As to the restriction of claim 19 from the product claims of Group I, the Examiner stated in Section 3 of the August 25, 2004 Office Action that "the process of using the product to alleviate the symptoms of systemic lupus erythematosus can be practiced with steroids." Applicants initially admit to some confusion about this basis for restriction. If the Examiner means that claim 19 covers treatment with both the product of claim 1 and a steroid, then the purported basis is not a basis at all because combined product is not materially different for purposes of §806.05(h). However, if the Examiner is suggesting that a steroid can be used in the method of claim 19 instead of the product of claim 1, then the purported basis is contrary to the explicit language of claim 19, which requires the use of the product of claim 1. Therefore, under either plausible interpretation, the purported basis fails to show that the method of claim 19 can be practiced with a materially different product, and the restriction should be withdrawn.

Furthermore, if this restriction requirement is maintained (which would be contrary to M.P.E.P. §806.05(f) and (h)) Applicants request pursuant to 37 C.F.R. §1.141(b) rejoinder of method of use claim 19, as well as the process of making claims 21, 32, 41, 43, and 52, once the elected product claims 1-18, 31, 42, 53, and 57-61 are deemed allowable.

Summary

In view of the remarks made herein, applicants maintain that the Examiner's restriction requirement made in the August 25, 2004 Office Action is not proper under 35 U.S.C. §121 and respectfully requests that the Examiner reconsider and withdraw the requirement.

If a telephone interview would be of assistance in advancing

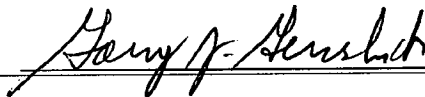
method of use claim 19, not only of the process of making claims of Group III. See, 37 C.F.R. §1.141(b).

Applicants: Sharon Cohen-Vered, et al.
Serial No.: 10/758,572
Filed : January 14, 2004
Page : 10

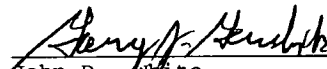
prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone at the number provided below.

No fee, other than the enclosed \$54.00 fee for filing additional claims, is deemed necessary in connection with the filing of this response. However, if any other fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

 9/24/04
John P. White Date
Reg. No. 28,678
Gary J. Gershik
Reg. No. 39,992

John P. White
Registration No. 28,678
Gary J. Gershik
Registration No. 39,992
Attorneys for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400